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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valley Dental, Inc.

Serial No. 74/651,834

Paul Grandinetti of Levy, Zito & Grandinetti for Valley
Dental, Inc.

Dominic J. Salemi, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before **Cissel**, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-identified application was filed on March 27,
1995, seeking registration on the Principal Register of the
mark "BERTHA BICUSPID" as a service mark for "promoting
dental services and dental health," in Class 42. Applicant
claimed first use and use in interstate commerce since
January 4, 1988, and stated that the mark is used "by
printing it on signs, brochures, booklets, letterhead,
labels, bulk mail, novelty items, and custom printed
products[,] by broadcasting on radio and television, and by

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other ways customary in the trade." The application included as specimens photocopies of the page shown below.

The Examining Attorney found the specimens to be unacceptable as evidence of service mark use of the term sought to be registered because it contains "no reference to a service." The Examining Attorney cited Trademark Rule 2.58 and required specimens which showed the term sought to be registered used to identify the services set forth in the application. Additionally, the original recitation of services was found to be indefinite, so amendment to the recitation was required.

Applicant responded by amending the application to restate the services as "promoting dental services and dental health through informative promotions." Applicant offered the following explanation of how the mark is used in connection with its services: "The applicant promotes its dental services and dental health through informative promotional material that is oriented to children. The promotions are signs, brochures, and advertisements and include characters in stories and/or cartoons that promote good dental practices."

Submitted with this explanation were thirty declarations from applicant's customers. In each, the declarant avers that he or she is familiar with applicant's advertisements for its services of promoting dental health and dental services, as well as a number of the marks applicant seeks to register. Each declarant further asserts

that he or she has come to associate the services provided by applicant with the specified marks, including the mark "BERTHA BICUSPID."

The Examining Attorney made the requirement for substitute specimens final with the second Office Action. Applicant was again advised that the specimens of record were "unacceptable as evidence of actual service mark use because they contain no reference to a service." Trademark Rule 2.58 was again cited as the basis for the requirement for substitute specimens. Again the Examining Attorney required amendment to the recitation of services because the existing one was found to be indefinite. He suggested adoption of "promoting dental services and dental health through personal visits by a costumed character."

On December 20, 1996, applicant appealed. Submitted with the notice of appeal was an amendment to the recitation of services. The application was amended to specify the services as "promoting dental services and dental health to children through the use of cartoon characters displayed upon promotional materials including balloons, pins, erasers, puppets, pencils, stickers, magnets, certificates, and club membership identification cards."

Also included were substitute specimens, supported by a proper declaration as to use at least as early as the filing date of the application. The specimens are copies of

promotional items which applicant states are given to children in schools and in other places as part of the service of promoting dental health. One specimen is a membership card for the "Tooth Tots Club," and features a cartoon character shaped like a tooth which bears the label "BERTHA BICUSPID." The card also prominently features applicant's name, "VALLEY DENTAL." Another specimen is a balloon on which are printed the words "VALLEY DENTAL" and "Tooth Tots Club," as well as the images of five tooth-shaped cartoon characters, including the one labeled with the mark sought to be registered. Still another of the additional specimens submitted with the notice of appeal bears similar images and wording, and includes the slogan "We'll Keep Your Family Smiling," along with a toll free telephone number. At the bottom of this promotional item the name "VALLEY DENTAL" is shown below "FRESNO," "CLOVIS" and "STOCKTON," which are locations of applicant's dental offices.

Responsive to applicant's amendment to the recitation of services and submission of the additional specimens, the Examining Attorney stated that "[t]he FINAL refusal made pursuant to Sections 1, and 2 of the Trademark Act is hereby continued." This statement was made notwithstanding the fact that no such refusal had ever been made, much less made final. The Examining Attorney went on to require again new

specimens because the specimens of record "contain no reference to a service," and again required amendment to the recitation of services, holding the amended version to be indefinite.

Both applicant and the Examining Attorney filed briefs, but no oral hearing was requested.

Based on careful consideration of the record in this application, as well as the pertinent legal authorities, we hold that the requirements for different specimens and an amendment to the recitation of services are unnecessary. This application is in condition for publication. The specimens applicant has submitted are acceptable evidence of applicant's use of the term it seeks to register as a service mark for the services set forth in the application, as amended, and that amended recitation of services is not unacceptably indefinite.

We note for the record that we are disregarding the language we quoted above from the Examining Attorney's last Office Action, as well as the references in his brief to the previously unmentioned "refusal made pursuant to Sections 1 and 2 of the Trademark Act." We are interpreting his words concerning those sections of the Act as simply another way of characterizing the issue which was raised by the Examining Attorney in every Office Action and his brief, and which was argued by applicant in every response and in its

appeal brief, i.e., whether the specimens show the mark sought to be registered used as a service mark to identify the services set forth in the application, as amended.

At the outset of our discussion of the merits of this appeal, we should address the issue of the requirement for a more definite recitation of applicant's services. As amended, the services are stated as "promoting dental services and dental health to children through the use of cartoon characters displayed upon promotional materials including balloons, pins, erasers, puppets, pencils, stickers, magnets, certificates, and club membership cards." We fail to see anything "indefinite" about this recitation. In fact, the listing of the particular promotional materials on which the mark is used may not have been necessary. The service, the activity performed for the benefit of others, is plainly stated as the promotion of dental services and health. The means by which such promotion is done are not as significant as the activity of promoting. In any event, we can see no legal, logical, or evidentiary basis for the Examining Attorney's repeated suggestion of an amendment stating that applicant promotes dental services and dental health "through personal visits by a costumed character." It eludes us why promotion through visits by a costumed character would be acceptable, but promotion through the use

of cartoon characters in a variety of printed materials given to children is not.

In summary, the existing recitation of services is acceptable. We note for the record that if applicant were only promoting its own services under the mark, registration as a service mark for these promotional services would not be proper because it is not a service to promote one's own services. This is apparently not the case, however. Applicant promotes dental services in general, rather than its own services in particular. In any event, the Examining Attorney has never refused registration on the basis that what applicant does under the mark is not a service because applicant is only promoting its own services.

As indicated above, we find that the specimens do show that applicant uses "BERTHA BICUSPID" as a service mark for applicant's service of promoting dental services and dental health to children. The Examining Attorney argues that the specimens of record are unacceptable because they do not specifically mention the promotion of dental services and dental health. The mere fact that the specimens of record do not specifically state that applicant offers "BERTHA BICUSPID brand dental services and dental health promotional services to children," however, does not disqualify the specimens.

Section 1 of the Lanham Act provides for the registration of marks used in commerce to identify services, and paragraph (A)(1)(C) of that section requires that specimens or facsimiles of a mark as used must be submitted along with the application, drawing and fee. The Court of Customs and Patent Appeals, in *In re Universal Oil Products Company*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973), discussed the requirement of Section 45 of the Act that in order to be registered as a service mark, a mark must be used in the sale or advertising of services. In his opinion in that case, Judge Rich, citing *Ex parte Phillips Petroleum Co.*, 100 USPQ 25 (Com'r. Pats. 1953), noted that the specimens in an application must show a "direct association" between the offer of services and the mark sought to be registered.

An example of how this standard can be met is provided in the more recent case of *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987). There, the Court took into account the specimens of record, as well as affidavits from purchasers of the applicant's services stating that they considered the mark sought to be registered to identify the services specified in the application. The Court concluded that the specimens submitted with the application showed the mark used to identify the services named in the application.

The situation in the case now before us is clearly analogous to that one. Here, the specimens, especially the substitute ones, show the mark sought to be registered used in materials which applicant provides to children as part of the service of promoting dental services and dental health. The cartoon character plainly labeled "BERTHA BICUSPID" appears in ways obviously intended to create in a child's mind a friendly and inviting image for having professional dental care. The front side of the "Tooth Tots Club" membership card shows the character smiling as she brushes herself with a toothbrush. "VALLEY DENTAL" is printed at the bottom. On the reverse side, children are encouraged to show the card in order to receive free "Tooth Tots Fun Packs & other club 'Goodies'" when they come in for their appointments. Applicant has explained that these materials are distributed to children in connection with the services of promoting dental health. Moreover, these services are provided without charge to educational and other institutions, and the services are also performed at applicant's dental clinics for children. Thus, applicant has shown that the materials are used as part of its program to promote dental health and dental services. The direct association in the mind of a child receiving these materials between "BERTHA BICUSPID" and the advantages of

getting dental care (i.e., the promotion of dental services and dental health) is plainly established by the record.

Further, just as in the Advertising & Marketing Development Inc. case, supra, not only are we presented with these unambiguous examples of the use of the mark in the kinds of ways such a mark would be used in connection with the specified service, we also have statements from a number of the purchasers of the services that they have come to associate the services of applicant with the mark. While this would not be persuasive evidence without specimens which show the mark used in connection with the services, this evidence confirms what the specimens establish, that applicant uses the mark in ways that create a direct association in the minds of purchasers between the mark and the services.

In summary, the recitation of services in this application, as amended, is sufficiently definite, and the specimens of record show the mark sought to be registered used in connection with the rendering of the specified services.

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Accordingly, the requirements for additional specimens and amendment to the recitation of services are reversed, and the application will proceed to publication.

R. F. Cissel

E. J. Seeherman

E. W. Hanak
Administrative Trademark Judges
Trademark Trial & Appeal Board